

REMARKS

Summary of the Office Action

In the Non-Final Office Action dated October 30, 2002, the Examiner indicates that the Information Disclosure Statement filed May 30, 2001 has been considered, an affirmation to the restriction requirement must be made, the disclosure needs to be amended, and claims 3-14 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,236,572 to Lam et al. (hereinafter Lam).

Summary of the Response to the Office Action

Claims 21-32 have been newly added. Accordingly claims 1 through 32 are currently pending, and claims 3-14 and 20-32 are under consideration. Applicants provide a replacement PTO-1449 as well as a copy of the stamped postcard receipt for the IDS of May 30, 2001.

The Information Disclosure Statement

Applicants thank the Examiner for the indication that the references of the IDS filed May 30, 2001 were filed. Applicants respectfully believe that a PTO Form 1449 was filed with the IDS as evidenced by the attached postcard receipt. However, as a convenience to the Examiner, Applicants provide a copy of the PTO Form 1449.

Applicants respectfully request that the Examiner evidence consideration of the references by initialing the PTO Form 1449 and returning a copy with the next communication.

The Pending Claims

It is also brought to the Examiner's attention that the Election/Restriction portion in the Non-Final Office Action makes reference to only claims 1-19. The Office Action summary indicates that claims 1-19 are pending. However, the originally filed claims are claims 1-20. Therefore, it appears claim 20 should be pending and under consideration. Claim 20 does not stand rejected.

The Disclosure

The Office Action alleges on page 3, paragraph 5, that the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper and that the Applicant is required to amend the disclosure to include the material incorporated by reference. The Office Action then states on page 4, lines 6-10 that "The attempt to incorporate subject matter into this application by reference to Japanese Patent Application No. 2000-167835 filed June 5, 2000 at page 25, last line and page 26 lines 1-2 is improper because the incorporation of essential material in the specification by reference to a foreign application or patent or to a publication is improper."

Applicants respectfully request reconsideration of the Office Action's requirement to amend the disclosure to include this particular material incorporated by reference in the instant application. It is not improper to incorporate a foreign application or patent by reference. It is only improper under MPEP §608.01(p) if the foreign application or patent contains "essential material". MPEP §608.01(p) goes on to state that "[n]onessential subject matter may be incorporated by reference to ... patents or applications published by the United States or foreign

countries or regional patent offices ..." The Office Action fails to point out any essential material that is lacking in the specification when it is taken without the material which has been incorporated by reference.

Accordingly, for at least the above reasons, Applicants respectfully submit that the incorporation by reference of the foreign document on page 25, last line and page 26, lines 1-2 of the instant application is not improper in view of MPEP § 608.01(p).

The Rejection Under 35 U.S.C. §102(b)

Claims 3-14 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated over Lam. The rejection is traversed as being based upon a reference that neither teaches nor suggests the novel features recited in the claims.

Independent claim 3 recites a process for producing an endless belt comprising a combination of steps including "forming a metallic thin film on an inner surface of a cylindrical substrate." The Office Action suggests that the mandrel 2 of Lam is a "cylindrical substrate" as claimed and that electrically conductive film formed on mandrel 2 in Lam is a "metallic thin film" as claimed. Applicants respectfully disagree.

As discussed at column 3, lines 46-52, for example, Lam teaches that the mandrel 2 can be a drum comprised of an electrically conductive material such a stainless steel or other metals having a dielectric material thereon for defining the pattern on the **radially outer surface** of the drum. Contrary to Lam independent claim 3 recites "forming a metallic thin film on an inner surface of a cylindrical substrate."

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. §102(b) should be withdrawn because Lam does not teach or suggest each feature of independent claim 3. As pointed out in MPEP §2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Furthermore, Applicants respectfully assert that dependent claims 4-14 are allowable at least because of their dependence from independent claim 3, and the reasons set forth above.

New Claims

Newly added independent claim 21 recites a process for forming an endless belt comprising amongst other steps, the step of “forming a metallic thin film on an inner surface of a drum.” Accordingly, Applicants respectfully assert that independent claim 21 is allowable. Furthermore, Applicants respectfully assert that dependent claims 22-32 are allowable at least because of their dependence from independent claim 21 and for the reasons set forth above.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite the prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 21-32 have been added.